

REMARKS

Claims 1 and 62-90 were pending in the above-captioned application. Claim 1 is canceled without prejudice to Applicant's right to pursue the subject matter of the canceled claim.

Claim 78 is amended to correct a clerical error. The preamble of claim 78, as filed, recited a method for purifying heat shock protein complexes. Similarly, claim 78, as filed, further recited the steps of binding of "the heat shock protein complexes to the ADP matrix," and removing "the heat shock protein complexes." However, claim 78, as filed, also recited "adding a solution containing a heat shock protein complex." Accordingly, claim 78 is amended to recite "adding a solution containing heat shock protein complexes" to conform to the preamble and the other recited steps in this method claim. No new matter is added by this correction of a clerical error.

Claim 83 was added in the Second Preliminary Amendment (filed March 29, 2005) and is now amended to correct a clerical error. Claim 83 was intended to recite "[a] method of synthesizing heat shock protein complexes" rather than "[a] method of synthesizing heat shock protein 70 complexes." That this is an error of a clerical nature is apparent upon a review of claims 84-86, which depend on claim 83, as well upon a review of Applicant's Notification to the Examiner under [former] 37 C.F.R. § 1.607 (*see* pages 8-9 of the Second Preliminary Amendment filed March 29, 2005).

More specifically, claim 84 recites "[t]he method of claim 83, wherein the heat shock protein is a heat shock protein 90 family member." Claim 85, which depends on claim 84, recites three individual members of the hsp 90 family. Since, the hsp90 family, and members thereof are obviously not encompassed within the "hsp70 family," it is apparent that claim 83 contains a mistake of a clerical nature. This conclusion is particularly obvious in view of dependent claim 86, which recites "[t]he method of claim 83, wherein the heat shock protein is not an hsp70 family member." That is, dependent claim 86 would make no sense if independent claim 83 were meant to be limited to those complexes in which the hsp was a member of the hsp70 family.

Thus, in view of the recitation of claims 84-86, Applicant submits that it is unambiguous that claim 83, as filed, was intended to be a generic claim encompassing a method for the synthesis of hsp complexes, including but not limited to, those in which the hsp was a member of the hsp70 family as well as those in which the hsp was a member of the hsp90 family.

That the recitation of “[a] method of synthesizing heat shock protein 70 complexes” is an error of a clerical nature is also apparent in view of Applicant’s statement in the Second Preliminary Amendment that claim 86 was intended to correspond to (and provoke an interference with) claim 2 of U.S. Patent 6,713,608 B2 to Wallen *et al.*, which claim is directed toward a generic method for synthesizing heat shock protein complexes, “wherein said heat shock protein complexes are non-hsp70 heat shock protein complexes.” Again, Applicant’s Notification to the Examiner under 37 C.F.R. § 1.607 simply would not make sense if claim 83 were intended to be limited to those complexes comprising hsp70, which are specifically excluded by claim 2 of the ‘608 patent.

Support for claim 83, as originally intended and as now amended, was provided in the Second Preliminary Amendment, at page 6, which stated that “[s]upport for new claim 83 is found at page 16, lines 5-24, and at page 36, lines 25-32, including the text inserted by the [First] Preliminary Statement filed August 12, 2003.” Accordingly, Applicant submits that the amendment to claim 83 does not add new matter.

RESPONSE TO RESTRICTION REQUIREMENT

The Examiner has required a restriction under 35 U.S.C. § 121 to one of three allegedly distinct inventions. Specifically, the Examiner required Applicant to elect one of the following groups of claims for examination on the merits:

- I. Claim 1, which is drawn to a method of eliciting an immune response to hsp70, classified in class 424, subclass 184.1;
- II. Claims 62-77, which are drawn to HSP 90 peptide complexes, and claims and 88-90, which are drawn to purified ADP-heat shock protein-peptide complexes, classified in class 530, subclass 350; and
- III. Claims 78-87, which are drawn to methods of purifying HSP complexes, and to methods of synthesizing HSP complexes, classified in class 530, subclass 412.

In response, Applicant respectfully traverses the restriction requirement and submits that, for the reasons provided below, the Examiner’s restriction of the claims into Groups II and III is improper. Since claim 1 is now canceled, the restriction with respect to Group I is moot.

The claims of Groups II and III are directed toward methods for the purification and for the synthesis of heat shock protein complexes as well as toward those heat shock protein complexes, *per se*. Applicant submits that a search of the subject matter of these two groups would not be a serious burden on the Examiner. Indeed, M.P.E.P § 803 (Eight Edition, Revision 2, May 2004) provides:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Applicant respectfully submits that it would not be an undue burden for the Examiner to search the subject matter of the claims of Groups II and III. Accordingly, on this basis alone, Applicant respectfully requests that the restriction requirement imposed under 35 U.S.C. § 121 be withdrawn and the subject matter of claims 62-90 be examined in one application.

Notwithstanding the above, in order to be fully responsive to the outstanding restriction requirement, Applicant hereby provisionally elects Group III, directed to the subject matter of claims 78-87, which are drawn to methods of purifying and methods of synthesizing heat shock protein complexes.

Attorneys for Applicant retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

CONCLUSION

Applicant respectfully requests that the present amendments and remarks be entered and made of record in the instant application. An early allowance of the application is earnestly requested. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Respectfully submitted,

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